

REMARKS

The Behrenfeld reference does not recognize the problem implicitly or explicitly that is one of the focuses of Applicants' claimed invention – oil-free and adhesive nature of the body. Rather, Behrenfeld's problem was a different subset of problems relating to impact pads and that was the problems inherent with impact pads having regular peripheral edges and the alleged shortcomings of these. Behrenfeld overcomes the prior art problem of impact pads having regular periphery surfaces for controlling the sounds by providing irregular peripheral edge which reduces drumhead distortion.

Behrenfeld discloses in Fig. 2A, a patch made up of: sheet 18 (example, polycarbonate, such as Lexan®), adhering to foam 29, which foam is coated with an adhering surface 22 (such as a 3M adhesive) for adhering to a drumhead. The embodiment of Fig. 2A may be placed on the drumhead or used separate and alone from the drum as a practice pad.

On the other hand, another embodiment, different from Fig. 2A, is that disclosed in Behrenfeld Fig. 2. This is simply a sheet 18 (again, polycarbonate, such as Lexan®, with an adhering surface 22 to adhere to a drumhead.

These are two different embodiments, one is not stackable on the other. The Examiner believes Behrenfeld shows they are "stackable," then they are two different patches being stacked one on the other, although this is not what Behrenfeld shows. In any case, if the Examiner construes them to be stackable they are different – the Lexan® sheet pad is not the foam pad.

The 3M adhesive is not shown to be oil-free, such as Applicants' oil-free polyurethane.

The Examiner's reference to Col. 3, lines 60-65, shows that a disk may be in a "hand" or "arm" of the patch. However, the disk is still part of the patch and the patch is always, at least some part thereof, located on the impact surface – even if the arms or the hands are not, the arms and the hands are still part of the patch.

Applicants' motivation has nothing to do with the ability of the edges to effectively control the sound. Instead Applicants are concerned with the aesthetics of the drumhead once the pad is stuck

to the drumhead and also the adhesiveness of the body to the drumhead – two areas which Behrenfeld teaches nothing new and the adhesiveness of the body to itself (stacking). In other words, Applicant had specific objectives in mind, adhesiveness and a body with adhesive properties, but one that would not aesthetically mar the drum surface.

Behrenfeld simply teaches nothing involved with the two objectives of the claimed invention (oil-free/adhesive). Behrenfeld does disclose the need for adhesion, but not any aesthetics or body-to-body considerations. Behrenfeld comes up short for disclosing or even suggesting anything that might provide these benefits. Behrenfeld discloses “tacky plastic toys that removably adhere to a surface.” That, of course, means nothing to one of ordinary skill in the relevant art. This is a non-enabling disclosure of any material that could perform the function of muffling and attaching all at the same time.

The substance of which the Behrenfeld pad is made is noted to be a “polycarbonate material.” The polycarbonate disclosed is not shown to be inherently oil-free, nor is there any reason to suggest or believe that such a characteristic is desirable. Moreover, the polycarbonate sheet disclosed DOES NOT adhere to the surface of the drum and requires it to be an adhesive to stick the polycarbonate onto the drum surface. This is not Applicant’s resilient body having oil-free properties and having adhesive properties to allow it to stick to the drum surface and thus for the reasons above Behrenfeld is not a proper 102 rejection.

Applicants believe the use of Behrenfeld as a 103 reference is not proper in part, because the reference does not address the oil-free/adhesive requirements of Applicant’s pad. Behrenfeld is all concerned with impact protection and the shape of the pad. Applicant is concerned with aesthetics and adhesiveness. Nothing in the Behrenfeld or any other cited reference raises the issue of unsightly stains left by dampening pads. Indeed, one would perceive from all of the cited prior art that you can use any kind of a body, even the most oily body, and just put an adhesive on it and stick it to the surface of a drumhead. This is not a suggestion leading to Applicant’s oil-free body that is adhesive to a drum surface.

Turning to the 103 rejections, Behrenfeld discloses a 20 mil (.020 inch) clear polycarbonate having its adhering surface comprising a 3M adhesive with removable paper sheet. Other impact pads are constructed of: leather, mylar, mylar with a metal disk sandwiched therein, rubberized fabric, and Kevlar® woven fabric – the preferred polycarbonate sheet is Lexan® (bottom of Col. 8 and carry over to paragraph, top of Col. 9).

Of course, none of these products have adhesive qualities that allow them to stick to the surface of the drum. Leather doesn't stick to the drumhead on its own; mylar doesn't stick to the drumhead on its own. There needs to be an adhesive surface. Applicant's claimed body is both a dampener, adhesive and oil-free. Nothing in Behrenfeld suggests that the adhesive surface that must be applied is oil-free.

Behrenfeld is all about shaping the impact pad to have an irregular shape to give it better properties. Of course, this is something Applicant has no interest in – Applicant, not being in the impact pad area. Further, it would make little sense to take an impact pad, which is designed to protect the surface of the drum from getting hammered directly by the drum sticks, to be placed in a non-impact position. Applicant does not care about the properties of impact or impact resistance that Behrenfeld focused on – the claimed invention focusing instead specifically on a non-impact portion of the drumhead. That is to say, with Applicants' objectives in mind, nothing in Behrenfeld would suggest the desirability of the disclosed pad in a non-impact position.

Claims 13-17 (method claims) stand rejected as unpatentable over Rosthauser in view of Liyama (JPO Reference Machine Translation) and Hardy. Claim 13 provides a method of manufacturing of a patch for applying to a vibratable surface of a musical instrument. All of the rejected Claims 13-17 specify the attachment of a polyurethane mix and non-woven base material for use with a vibratable surface of a musical instrument when no portion of the mix is placed at the point of impact – in other words, the rejected claims are not directed to impact pads, they are directed to dampening pads.

Rosthauser is not proper prior art. One of ordinary skill in the dampening pads industry is not a chemist and is not likely to understand or even be directed to, for any reason at all, the Rosthauser reference. In other words, the claimed method of manufacturing of a patch for a vibratable musical instrument is the proper art, not the Rosthauser reference, which is directed to a method of production for polyurethane backing on textiles for floor coverings and other polyurethane components. Indeed, the only apparent reason the Examiner went to Rosthauser was because of the word “polyurethane,” and the Examiner found the word “polyurethane” from the claims. This is classic hindsight reconstruction. One cannot start with the claims and locate the prior art with respect to the claims. One can and should start with where the person of ordinary skill in the art, trying to invent a new method of making an aesthetic patch for application to the non-impact surface of a musical instrument, would start – with prior art known methods for making the same. What the Examiner has done here is used the claim term “polyurethane mix” to locate prior art that has polyurethane mix, but that prior art has nothing to do with manufacturing methods for vibratable musical instruments.

The Examiner has not provided any reason that a person of ordinary skill in the art faced with the express motivations of the inventor (that is, directed to manufacturing patches for application to a vibratable surface of an instrument) would be directed to polyurethane mix. Rosthauser does not teach, expressly or implicitly something like: “the method enclosed herewith might be useful in making dampening patches”. Nor does Liyama state anything about musical pads. The apparent reason the Examiner ended up with polyurethane prior art is that it is in the claims. This is, of course, improper hindsight. One must start with prior art itself (that is, nothing at all from the patent application) and, in those relevant prior art patents, the Examiner must find all the elements of the claimed invention as well as some reason in the prior art or some articulated specific reason (starting with Applicants’ objectives) for combining the two. There is no reason that one would be led by Hardy to polyurethane. The word “polyurethane” is not in Hardy. No one would one starting with Hardy (since it does have to do with deadening drumheads) would be led to

the other two references. Hardy discloses the use of a pad of foam rubber, foam polyester or other coarse and pliable material with an adhesive layer 52 disposed on the pad.

The Examiner has stated that it would have been obvious to one of ordinary skill in the art of the invention to combine Rosthauser and Hardy in order to make Rosthauser's polyurethane coated patch applicable for sound dampening function of a drumhead. However, this begs the question: Why use Rosthauser's polyurethane coated patch? Hardy doesn't say there is anything wrong with its own adhesion or with its wet-out properties. In other words, nowhere in Hardy, which is pertinent to the extent that it is in vibratable musical devices art, does Hardy say "adhesion is a problem and so are wet-out properties." If Hardy expressly recognized those shortcomings, then perhaps one would be led to Rosthauser – if, which is not the case here, Rosthauser recognized polyurethane's improved sound dampening function, patch adhesion (to a drumhead) and wet-out properties. Both ends of the equation for a proper §103 reference are missing here – that of the recognition in the prior art of an express motivation or shortcoming that would make it desirable to use "something else" – as well as finding the "something else" in another piece of prior art which would be relevant to a person of ordinary skill in the art. One cannot find in Hardy what is not there – improved adhesion and wet-out properties, and one cannot find in Rosthauser a solution in the polyurethane coated patch – unless directed to polyurethane by the claims (which would be improper hindsight).

Hardy does address a specific problem. Hardy recognizes that the weight and bulk of pillows, rugs, etc. that were previously used in drums were inconvenient, especially for marching drums, because they are large and bulky. In an effort to solve that problem, a simplified and versatile device that was sought, which could be quickly, easily and securely attached to the drumhead so that the drummers need not carry a bulky device (such as a pillow, rug, etc.) apart from the drum itself.

Hardy solved that bulk problem with his claimed device. What the Examiner is trying to do is find some motivation in Hardy that would lead to polyurethane (because polyurethane is in Applicants' claim). It's not there. No motivation is found in Hardy that would lead anyone to

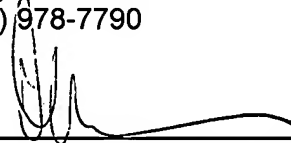
polyurethane. What the Examiner attempts to do is to substitute a polyurethane patch for what the Examiner perceives to be shortcomings of the Hardy patch. The Hardy patch solved the solutions of the Hardy need (less bulk). It is not proper for the Examiner to find some kind of implicit shortcoming of the Hardy patch and use the Hardy statement of the problem to get to somewhere else – in this case, to a non-pertinent reference that was found only by improper hindsight.

In view of the above, Applicant respectfully requests reconsideration.

Respectfully submitted,

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